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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,775	06/29/2001	Will H. Gardenswartz	OBSP5GARD-USC2	5962

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/893,775	GARDENSWARTZ ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1 and 55-87* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 55-87* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 May 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 March 2005 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 1 is rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. (US pat. 5,459,306) and Herz et al.

5. Biorge et al. teaches a method for delivering *incentive credits,* which reads on targeted advertising, comprising: receiving from a first computer *(the portable device)* a first identifier *(encrypted signals)* identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/ targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

6. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A "purchase" is an exchange for money or its equivalent (Merriam-Webster's Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.

7. Biorge et al. does not teach that that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.

8. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.

9. Claim 55, 56, 62-69, 72, 86 and 87 is rejected under 35 USC 102(b) as anticipated by Stein et al. (US pat. 5,459,306).

10. Stein et al. teaches (independent claims 55, 86 and 87) a computer network implemented method and system for delivering targeted advertisements, the method comprising: collecting a first consumer/customer/*user* offline purchase history and identification (col. 2 lines 42-43 and 65-66); storing said consumer/customer/*user* information (col. 4 lines 14-19); (inherently) receiving from *kiosk* ***5*** its network address, which reads on a "consumer computer first identifier" (para. 11 below), sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller* ***9***, which reads on associating said first identifier/kiosk network address with said first consumer identification/*user code*, and determining a targeted advertisement (*targeted promotions*, col. 1 lines 10-12) for said first consumer based at least in part on said offline purchase history associated with said first consumer identification/*user code* with said first identifier/*kiosk* ***5*** its network address (col. 6

lines 28-51); and delivering said determined targeted advertisement to said first consumer (col. 6 lines 55-57).

11. Stein et al. does not explicitly teach that *kiosk **5*** has a network address. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Stein et al. teach a plurality of *kiosks **5*** and other network elements in communication with *coupon controller **9*** (col. 6 lines 28-45 and Fig. 3). *Coupon controller **9*** could return the coupons/promotions to the correct *kiosk **5*** only if each such network element had its own network address.

12. Stein et al. also teaches at the citations given above claims 56, 63 (where the *kiosk **5*** network address reads on "a value corresponding to a cookie"), 64 (where *coupon controller **9*** reads on an advertiser's server) and 65-67.

13. Stein et al. also teaches claim 62 (col. 5 line 59), 68 and 72 (where *host system **13***, jointly with *coupon controller **9***, reads on said analytical computer because it provides *rules for predicting purchases*, col. 4 line 13 and col. 5 lines 9-12), 69 (col. 4 line 14),

14. Claim 70 is rejected under 35 USC 103(a) as obvious over Stein et al. in view of Willman et al. (US 20030195806A1). Stein et al. does not teach analysis of consumer data and selection of promotions in real time. Willman et al. teaches analysis of consumer data and selection of promotions in real time (para. [0008-0009]). Because Willman et al. teaches that this eliminates many problems in coupon distribution (para. [0004-0007]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Willman et al. to those of Stein et al.

15. Claim 57-61, 71 and 73-85 are rejected under 35 USC 103(a) as obvious over Stein et al. Stein et al. does not teach the purchase history data limitations of claims 57-61, IVR (claim 71) or registration at a web page (claims 73-85). Official notice is taken (MPEP § 2144.03) that all of the purchase history data was commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention. It is obvious to follow common practices.

16. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

17. The instant application contains no such clear definition for any terms, including "online/offline", "consumer computer", "retail store", "association table", "analytical computer system", "advertiser's server" and "registration server". The spec. does define online/offline in para. [0004] of the published application (US 20020046105A1), but this definition is flawed by not defining grocery stores connected to a computer network. In the instant case, the examiner is required to give these terms their broadest reasonable interpretation.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

28 May 2005

DONALD L. CHAMPAGNE
PRIMARY EXAMINER